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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,378	12/03/2003	Wei Fan	YOR920030321US1	3137
48150 7590 05/27/2009 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER COUGHLAN, PETER D				
ART UNIT		PAPER NUMBER		
2129				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,378

Applicant(s)

FAN ET AL.

Examiner

PETER COUGHLAN

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-15 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-15 and 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/3/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. This office action is in response to an AMENDMENT entered March 11, 2009 for the patent application 10/725378 filed on March 11, 2009.
2. All previous Office Actions are fully incorporated into this Non-Final Office Action by reference.

Status of Claims

3. Claims 1, 2, 4-11, 13-15, 17-33 are pending in this application.
4. Examiner's Comments;

Dependent claim 18 is dependent to claim 16 which was cancelled by the applicant. This claim needs to be amended to be dependent on an existing claim.

The Examiner faxed the following proposed amendments to Mr. Cooperrider on 5/19/09 which the Examiner would permit allowance.

Claim 1

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A computer implemented method of processing an inductive learning model for a dataset of examples for a charity donation database from which will be selected a subset of individuals to whom to send campaign donations request, said computer method comprising:

a processor that divides said charity donation dataset into a plurality of subsets of data; and

a processor which retrieves a first subset of data of said charity donation database from a memory;

using a processor on a computer for developing an estimated learning model for an entirety of said charity donation dataset by developing a learning model by using a base classifier calculator for said first subset of said plurality of subsets, said estimated learning model thereby providing an estimated model for said dataset that is obtainable without processing an entirety of said dataset and

developing, using said processor, at least one of a current accuracy and an estimated final accuracy, said current accuracy comprises an accuracy of said learning model for said subset, said estimated final accuracy comprising an estimated accuracy of said estimated learning model for said entirety of said charity donation dataset.

Claims 1-7 would be allowed.

Claims 8-33 are to be cancelled

Comments

This invention is the use of non-parametrics statistics with out replacement regarding data associated with charity donation behavior used as input data.

Other independent claims

Independent claim 8 and 20 are too broad. Claim 1 cited above has portions of claim 8 incorporated within claim 1.

Claim 11 introduces the term 'ensemble' and used as 'ensemble model and 'ensemble calculator.' This independent claim adds nothing significant to the invention and clutters the cited domain of the invention.

Claim 14 still has 'signal bearing storage medium' which was addressed under 35 U.S.C. §101 in the last Office Action. The amended specification does not clarify this issue. The amended specification states '...and instructions stored in transmission

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formats, such as digital and analog formats and including transmission media such as devices used for communication links and wireless.' This amended specification does not address the issue stated in the previous Office Action.

Claim 25 introduces 'true class label' regarding portions of the datasets. Knowing that some of the data is labeled 'true' adds nothing significant to the invention and clutters the cited domain of the invention.

Specification

Paragraph 0206 is to read

[0206] Whether contained in the diskette 1300, the computer/CPU 1211, or elsewhere, the instructions may be stored on a variety of machine-readable data storage media, such as DASD storage (e.g., a conventional "hard drive" or a RAID array), magnetic tape, electronic read-only memory (e.g., ROM, EPROM, or EEPROM), an optical storage device (e.g. CD-ROM, WORM, DVD, digital optical tape, etc.), paper "punch" cards. In an illustrative embodiment of the invention, the machine-readable instructions may comprise software object code.

The Examiner made a follow up phone call to Mr. Cooperrider on 5/22/09 to determine the status of the proposed amendments. Mr. Cooperrider stated there was no reply from the inventors.

35 USC § 101

5. In the last Office action, the Examiner stated, 'Claims 14-19 are rejected under 35 U.S.C. §101 by use of the term 'signal bearing media.' In ¶0206, the specification defines signal bearing media as 'including transmission media such as digital and

analog communications.' Transmission media such as digital and analog communications are unable to store instructions and are nonstatutory.'

The applicant altered the specification to read,

'Such a method may be implemented, for example, by operating a computer, as embodied by a digital data processing apparatus, to execute a sequence of machine-readable instructions. These instructions may reside in various types of signal-bearing media, wherein signal-bearing means that the media has functionality to interact with the apparatus to execute the instructions.

Thus, this aspect of the present invention is directed to a programmed product, comprising signal-bearing storage media tangibly embodying a program of machine-readable instructions executable by a digital data processor incorporating the CPU 1211 and hardware above, to perform the method of the invention.

This signal-bearing storage media may include, for example, a RAM contained within the CPU 1211, as represented by the fast-access storage for example. Alternatively, the instructions may be contained in another signal-bearing storage media, such as a magnetic data storage diskette 1300 (FIG. 13), directly or indirectly accessible by the CPU 1211.

Whether contained in the diskette 1300, the computer/CPU 1211, or elsewhere, the instructions may be stored on a variety of machine-readable data storage media, such as DASD storage (e.g., a conventional "hard drive" or a RAID array), magnetic tape, electronic read-only memory (e.g., ROM, EPROM, or EEPROM), an optical

storage device (e.g. CD-ROM, WORM, DVD, digital optical tape, etc.), paper "punch" cards, or other suitable signal-bearing storage media including memory devices in transmission media and instruction stored in transmission formats, such as digital and analog formats, and including transmission media such as devices used for communication links and wireless. In an illustrative embodiment of the invention, the machine-readable instructions may comprise software object code.'

This does not change or omit the meaning of using 'storage media' which includes 'memory devices' or 'instructions stored in transmission formats' which include 'digital and analog formats and including transmission media such as digital and analog formats.

The Office's position is that carrier waves and other similar transmission media can not be used as storage media. The functions of storage and transmission are two different concepts. Paragraph 0203 must be amended so that a transmission media can not be used as a storage media.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 4-7, 13-15, 17-33 are rejected under 35 U.S.C. 101 for nonstatutory subject matter.

The method claims recited do not pass the machine-transformation test.

The portions of the opinions in State Street and AT&T relying solely on a “useful, concrete and tangible” result analysis should no longer be relied on. Ex parte Bilski, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

The court has said that there's a two-pronged test to determine whether a software of business method process patent is valid: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. In other words, pure software or business method patents that are neither tied to a specific machine nor change something into a different state are not patentable. Ex parte Bilski, Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

*The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a **particular** machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose **meaningful limits on the claim's scope** to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must **not** merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590. (See in re Bilski, 88 USPQ2d at 1396, emphasis added.)*

The claimed invention needs to pass the machine-transformation test.

Examination Considerations

6. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has the full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

7. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and sprit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but link to prior art that one of ordinary skill in the art would find inherently appropriate.

8. Examiner's Opinion: Paragraphs 6 and 7 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

9. The prior art of record and not relied upon is considered pertinent to the applicant's disclosure.

-U. S. Patent Publication 20030055779: Wolf

10. Claims 1, 2, 4-11, 13-15, 17-33 are rejected.

Correspondence Information

11. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3080. Any response to this office action should be mailed to:

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Hand delivered to:

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401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 272-3150 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/P. C./

Examiner, Art Unit 2129

Peter Coughlan

5/26/2009

/David R Vincent/

Supervisory Patent Examiner, Art Unit 2129